

RemarksRejections Under 35 USC 102:

Claims 1 and 2 were rejected under 35 USC §102(b) as being anticipated by Maesako et al. (US Pat. No. 6016280). In particular, the Examiner states that Maesako discloses the Applicant's claimed subject matter in the abstract and in FIG. 4. In response, independent claim 1 was amended to include the limitation that the operating parameters comprise temperature, current draw, or access time. Analysis of Maesako reveals that Maesako fails to teach or otherwise suggest a controller making intelligent decisions on where to write data based on temperature, current draw, or access time.

It should be noted that these limitations were originally found in dependent claim 3, which was rejected under were rejected under 35 USC §103(a) as being unpatentable over Maesako in view of Schade. Notwithstanding this fact, the Applicants can find no suggestion in either reference of a controller making intelligent decisions on where to write data based on temperature, current draw, or access time. Because of this, claims 1 and 2 are allowable over the prior art of record.

Claim Rejections Under 35 USC 103(a):

Claims 2-5 were rejected under 35 USC §103(a) as being unpatentable over Maesako in view of Schade (US Pat. No. 6473831). In particular, Examiner Nguyen states that, "Maesako discloses all the inventions of claims 2, 3, 5 except for a database storing different operating parameters of different memories." Examiner Nguyen states that this limitation can be found in Schade. Examiner Nguyen concludes that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings by Maesako with the teachings by Schade in order to come up with the inventions of claims 3, 4, 5 with a "purpose of improving a semiconductor device."

As discussed above, the combination of Maesako and Schade fail to teach or otherwise suggest the Applicants' claimed step of a controller making intelligent decisions on where to write data based on temperature, current draw, or access time. Because of this, claims 2-5 are allowable over the prior art of record.

Notwithstanding the above arguments for patentability, analysis of Maesako and Schade reveal that nowhere in either reference is there a suggestion or motivation to combine the two. **The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure.** (MPEP 706.02(j)). As is stated in the MPEP, in order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to combine the references. MPEP 706.02(j). Analysis of both Maesako and Schade reveal that they *both* teach a technique for writing to mixed-memory devices. Thus, both references solve the same problem. Thus, if one used the techniques of Maesako to write to mixed-memory devices, there would be no motivation to use the teachings of Schade, since the problem of writing to mixed-memory devices has been solved. The contrary is also true, since if one used the techniques of Schade to write to mixed-memory devices, there would be no motivation to use the teachings of Maesako, since the problem of writing to mixed-memory devices has been solved. Since both references actually teach away from their combination, nowhere in either reference is there a suggestion or motivation to combine the references. For these reasons, the Applicant requests the Examiner to withdraw the obviousness rejection under 35 USC §103.

Regarding amended claim 3, this claim was amended to specifically claim the fact that a controller makes intelligent decisions on where to write data based on all three parameters (temperature, current draw, and access time). This limitation is neither taught nor suggested by the prior art of record.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references. As the Applicant has overcome all substantive rejections given by the Examiner the Applicant contends that this Amendment, with the above discussion, overcomes the Examiner's rejections to the pending claims. Therefore, the Applicant respectfully requests allowance of the application. If the Examiner is of the opinion that any issues regarding the status of the claims remain after this response, the Examiner is invited to contact the undersigned representative to expedite resolution of the matter. Finally, please charge any fees (including extension of time fees) or credit overpayment to Deposit Account No. 502117.

Respectfully Submitted,
Brazis, ET AL.

by: 

Kenneth A. Haas
Reg. No. 42,614
Phone: (847) 576-6937
FAX: (847) 576-3750